

IN THE CLAIMS:

Cancel Applicant's CLAIMS 2 - 11 added in the Response dated February 25, 2000 and filed February 22, 2000; and, substitute the new Claims 2 - 11 attached.

REMARKS

Claim 1 has been cancelled; and, new Claims 2 - 11 have been added.

It is believed that no additional filing fees are due; however, should there be an error and additional fees are due, please charge such fees to Deposit Account No. 02-2872.

Applicant has previously executed and filed a Power Of Attorney in favor of the undersigned representative, yet the outstanding Office action (Paper No. 9) was still mailed to Applicant at his residence.

The Examiner should note the error in the filing date indicated on Page 1 of the outstanding Office action (Paper No. 9). The outstanding Office action (Paper No. 9) states the filing date as "04/13/99"; whereas, the actually filing date is January 19, 1999 (See, the Official Filing Receipt - Form PTO 103X). Applicant's undersigned representative again asks that the Examiner correct this error in his next communication.

Applicant submitted a new Abstract Of The Disclosure with the Response dated February 25, 2000 and filed February 22, 2000.

The applicant filed a CORRECTED informal drawing (FIGURES 1 - 3) with the Response dated February 25, 2000 and filed February 22, 2000.

The Examiner objected to the Response dated February 25, 2000 and filed February 22, 2000, as "not fully responsive." The specification and claims have been amended and presented in proper form, the specification being "certified." No new subject matter has been added that was not disclosed in the application as originally filed. 35 U.S. Code § 121. A copy of the original specification and drawing are attached to show that there are no differences between the original specification and certified substitute.

Claim 1 was rejected as "failing to define the invention" in the manner required by 35 U.S. Code § 112, second paragraph. Claim 1 has been cancelled and new Claims 2-11 have been added.

The Examiner rejected Claim 1 under 35 U.S. Code § 102(b) : "as being anticipated by Staley 3304646"; and "as being anticipated by Otterson 4244134." Further, the Examiner rejected Claim 1 under 35 U.S. Code § 103(a) "as being unpatentable over Meyer et al 1545005

in view of Otterson 4244139 (Sic)." Claims 2 and 8, the newly added independent apparatus claims; and, Claim 11, the newly added independent method claim, include the structural limitations of the tray having a contiguous side wall, a portion of the side wall having a protuberance depending upwardly therefrom, and further defines the functional capability and method steps of the inverted trap causing the protuberance to rest on the preselected (infested) surface and create a space between the surface and the adhesive which allows an insect or rodent to reach the adhesive (and/or bait) provided in the tray, as illustrated in FIGURE 2. Staley '646, Otterson '134 and Meyer, et al. '005, while they disclose traps with adhesive, do not teach the tray having a contiguous side wall, a portion of the side wall having a protuberance depending upwardly therefrom. Applicant's device provides structure and functionality wherein the inverted trap causes the protuberance to rest on the preselected (infested) surface and create a space between the surface and the adhesive which allows an insect or rodent to reach the adhesive (and/or bait) provided in the tray.

The standard for any non-obviousness determination under 35 U.S. Code § 103 has been defined by the CAFC in *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 221 USPQ 929

(Fed. Cir. 1984). *Carella v. Starlight Archery*, 231 USPQ 644 (Fed. Cir. 1986). As the court stated in *Montefiore Hospital*, the focus in any § 103 analysis is on the differences between the claimed subject matter and the prior art. Here the claimed invention exhibits the functional capability of the inverted trap causing the protuberance to rest on the preselected (infested) surface and create a space between the surface and the adhesive which allows an insect or rodent to reach the adhesive (and/or bait) provided in the tray (FIGURE 2).

This claimed structure and functionality distinguishes over the prior art of record. The references, either standing alone or in combination, neither disclose nor suggest to one of ordinary skill in the art the use of such a trap.

The Examiner's heavy reliance on the argument that it would be obvious to one of ordinary skill in the art that Staley '646, Otterson '134 or Meyer, et al. '005 could be modified in view of each other to show a trap having a tray having a contiguous side wall, a portion of the side wall having a protuberance depending upwardly therefrom, appears to be no more than hindsight reconstruction of the claimed invention. *ACS Hospital Systems, Inc. v. Montefiore Hospital, Carella v. Starlight Archery, supra*,

*In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). There is no source other than the application itself with the suggestion to use such structure and functioning in a trap. In other words, Applicant's own disclosure is being used as a reference to reject his own invention, which has never been permitted by U.S. patent law. *In re Murray, et al.*, 122 USPQ 364; *In re Kam*, 172 USPQ 298; and, *In re Roberts*, 176 USPQ 313. Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching or suggestion supporting the combination. Under § 103, the teachings of references can be combined only if there is some suggestion or incentive to do so, *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 221 USPQ at 933. In other words, any combination of Staley '646, Otterson '134 or Meyer, et al. '005 is improper to reject Applicant's claimed invention as these references do not provide motivating force to impel a person skilled in the art to do what Applicant has done. *Ex Parte Levengood*, 28 USPQ 2d 1300 (Bd. Pat. App. & Inter. 1993). The prior art of record fails to provide any suggestion or incentive for such a trap. Accordingly, the Applicant submits that the claimed invention would not have been obvious to one of ordinary skill in the art under § 103 and is, therefore, allowable.

Based on the above amendments and remarks, it is submitted that all of the claims remaining in the case are now allowable and an early Notice of the same is respectfully solicited. If the Examiner feels a telephone conference will in any way expedite the disposition of this matter, he is respectfully invited to contact this attorney at (504) 861-8288.

Respectfully submitted,  
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on August 11, 2000.

  
George A. Bode - Reg. No. 30,028  
Assignee's Registered Representative

11 August 2000  
Date of Signature